

## REMARKS

This paper responds to the office action dated December 12, 2007. A diligent effort has been made to respond to the objections and rejections set forth therein, and reconsideration is respectfully requested.

The previous office action rejected all of the claims then pending under 35 U.S.C. § 103 as being unpatentable over U.S. Publication No. 2004/0192282, application of Vasudevan (Vasudevan) in view of U.S. Patent No. 6,836,657, issued to Ji, et al. (Ji). (The rejections of claims 9 and 52 in that office action further cited the Cheng reference in addition to Vasudevan and Ji.) In response to the office action's rejection of the pending claims, applicants argued that not only did the Ji reference not teach the subject matter of the pending claims, but that it actually taught away from the subject matter of the claims. Given that the currently pending office action withdraws all of the previous rejections based on Vasudevan and Ji and cites new grounds of rejection, it appears that the applicants' characterization of the Ji reference in the response to the previous office action was correct.

In place of the combination of Vasudevan and Ji, the current office action rejects claims 1, 4-6, 16, 48-50, and 53 under 35 U.S.C. § 103(a) over the combination of Vasudevan and U.S. Publication No. 2007/0169073, application of O'Neill, et al. (O'Neill). The O'Neill reference, though, suffers the same shortcoming as did the Ji reference. In addition, O'Neill, like Ji, teaches away from the subject matter of the pending claims. Thus, the rejection is faulty and should be withdrawn.

The office action states that Vasudevan fails to disclose creating an updated mobile device configuration within the available memory of the mobile device memory, and maintaining the baseline mobile device configuration within the mobile device memory after creating the

updated mobile device configuration within the available memory of the mobile device memory, where the baseline mobile device configuration is maintained within the mobile device memory for a period of time sufficient to allow the updated mobile device configuration to be tested, as required by claim 1. The office action goes on to state, though, that “this feature is very well known in the art as taught for example by O’Neill.” However, O’Neill fails to teach this aspect of the subject matter of claim 1. In support of the allegation that this limitation of claim 1 is found in O’Neill, the office action cites paragraphs 31 and 38-39. At the end of paragraph 31, O’Neill states:

At the end of the download, the mobile devices verifies that it received an appropriate update package, validates the update package contents employing, for example, CRC checks, an MD5 checksum, etc., and **applies the update package to update the existing version of firmware and/or software** in mobile device 109. (Emphasis added.)

As this passage states explicitly, O’Neill teaches applying the update to the existing version of the firmware and/or software on the mobile device. This is the opposite of what is required by claim 1, namely maintaining the baseline configuration after creating the updated configuration, and thus this teaching would tend to lead a person of ordinary skill in the art away from the solution recited in the instant application.

The office action also cites paragraph 39 of O’Neill as grounds for rejecting claim 1. Paragraph 39 discloses even more explicitly the manner in which O’Neill teaches away from the subject matter of the pending claims. Paragraph 39 reads:

The update package and the existing memory binary image integrity are tested prior to applying the update at the mobile device 109. Following successful verification, the update package may be applied to the existing memory image at the mobile device 109. Fault tolerance and redundancy may be used to permit recovery in the event of power loss or interruption. Once the memory binary image of the mobile device 109 has been fully updated, the update agent 123 in the mobile device 109 may perform a final error check and close the update process.

This passage plainly states that the update package and existing memory binary image are tested before the update package is applied to the existing memory image. Thus, this paragraph cannot disclose the subject matter of claim 1 that O'Neill purportedly teaches. Similarly, the last portion of the paragraph describes a final error check that may take place before the update process is closed, but the error check described only takes place once the memory binary image of the mobile device has been fully updated. So, there is nothing in the cited passages from O'Neill that could teach the subject matter of claim 1, and the teaching that O'Neill does contain would tend to teach away from the solution recited in the pending claims. Thus, claim 1 is patentable over the cited references and should proceed to issuance. Further, claims 48 and 53 recite subject matter analogous to the subject matter of claim 1, and the grounds cited in rejecting claims 48 and 53 are the same as those cited in rejecting claim 1. Therefore, claims 48 and 53 are also patentable for at least the reasons set forth above with respect to claim 1.

Applicants disagree with other positions in the office action as well. For example, the office action rejects claims 8, 9, 51, 52, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Vasudevan in view of O'Neill and further in view of U.S. Publication No. 2003/0046676, application of Cheng, et al. (Cheng). In rejecting claims 8, 9, 51, 52, 54, and 55, however, the office action lumps all of the claims together and provides an incomplete analysis as to the applicability of the cited references to the subject matter of the rejected claims. For example, nothing in the analysis provided in the office action even addresses the subject matter of claims 8, 51, and 54. This subject matter is distinct from the subject matter of claims 9, 52, and 55, but the analysis only discusses the subject matter of claims 9, 52, and 55. The MPEP plainly states:

Once the findings of fact [under *Graham v. John Deere Co.*] are articulated, Office personnel must provide an explanation to support an

obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability. (MPEP § 2141(II).)

Because the office action provide no substantive basis to support the rejections of claims 8, 51, and 54, applicants respectfully submit that claims 8, 51, and 54 are allowable and should proceed to issuance.

Applicants also disagree with the office action's rejection of claim 9, 52, and 55. As the examination guidelines concerning rejections under 35 U.S.C. § 103 state, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." (MPEP § 2141(III).) Quoting the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, the examination guidelines go on to state that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (MPEP § 2141(III).) The rationale provided in the pending office action for rejecting claims 9, 52, and 55, however, merely restates the language of the rejected claims and states that it would have been obvious to one of ordinary skill in the art to combine the cited references in order to gain the benefits of "enabl[ing] the user to restore the client computer to its state prior to the installation, including restoring any files that were deleted or altered." The MPEP provides seven separate exemplary rationales for supporting a conclusion of obviousness (see MPEP § 2143), yet the office action cited none of these seven nor any other rationale. Mere conclusory statements of the type included in the pending office action cannot sustain an obviousness rejection, as made clear by the Supreme Court in *KSR*.

Further, even the mere conclusory statements mischaracterize the subject matter of the rejected claims. The reference in the office action to “enabl[ing] the user to restore the client computer to its state prior to the installation, including restoring any files that were deleted or altered” is fundamentally at odds with the subject matter of claims 9, 52, and 55. These claims recite that two separate configurations are maintained on a mobile device, one a baseline configuration, the other an updated configuration, and that a user chooses between the baseline configuration or the updated configuration. If a user selects the baseline configuration, as might be the case for example if the updated configuration did not function properly on the mobile device, then there is no need to “restore” the client computer, as indicated in the office action’s characterization of the cited references. Rather, in that example, the baseline configuration is maintained on the mobile device. There is no need to “restor[e] any files that were deleted or altered,” because both the baseline and updated configurations were maintained on the mobile device prior to the user’s choice of one or the other. Thus, the characterization of the cited references in the office action does not disclose the subject matter of claims 9, 52, and 55. For at least the reasons set forth above, claims 8, 9, 51, 52, 54, and 55 are patentable over the cited references and should proceed to issuance.

It is noted that applicants have not presented arguments with respect to one or more of the dependent claims pending in the instant application. This is done without prejudice to applicants’ right to present arguments with respect to each of the pending claims at any point in the future. Further, because each of the dependent claims in the instant application depends from an independent claim that is patentable, the dependent claims are themselves patentable for at least the reasons set forth with respect to the independent claims.

**CONCLUSION**

This application is now in condition for allowance.

Respectfully submitted,

JONES DAY

A handwritten signature in cursive script that reads "David B. Cochran". The signature is written in dark ink and is positioned above a horizontal line.

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